

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the present amendment and following discussion is respectfully requested.

Claims 14-30 are pending. Claims 25 and 26 are withdrawn. By the present amendment, the Title, the specification, and Claims 14-25 are amended; Claims 27-30 are added; and no claims are canceled. Support for the amendment to the Title may be found at least in Claim 14. Support for the amendment to the specification is self-evident. Support for the amendments to Claims 14, 20, and 25 may be found in Fig. 4, and in the corresponding description of that figure, for example. Support for the amendments to Claims 2-19 and 21-23 is self-evident. Support for the amendment to Claim 24 may be found at least in paragraph [0037] of the specification, as published. Support for new Claims 27-30 may be found in Figs. 1 and 4, and in the corresponding description of those figures, for example. It is respectfully submitted that no new matter is added.

In the outstanding Office Action, the specification is objected to for failing to include section headings under 37 C.F.R. § 1.77(b), and for not capitalizing the trademarked word “Teflon;” the Title is objected to as not descriptive; Claims 14-24 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite; Claims 14-17, 20, and 22-24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Benz et al. (EP 0530617, hereinafter “EP ‘617”) in view of Chalker (U.S. Pat. No. 2,100,587, hereinafter “U.S. ‘587”); Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over EP ‘617 in view of U.S. ‘587 and Takaharu (JP 06-063504, hereinafter “JP ‘504”); and Claim 21 is rejected under 35 U.S.C. § 103(a) as unpatentable over EP ‘617 in view of U.S. ‘587 and Boer et al. (U.S. Pat. No. 4,393,805, hereinafter “U.S. ‘805”).

At the outset, Applicants note with appreciation the courtesy of a personal interview granted by Primary Examiner William Fletcher to Applicants’ representatives. In accordance

with M.P.E.P. § 713.04, the substance of the personal interview is substantially summarized below.

Regarding the objections to the Title and specification, as discussed during the personal interview, the Title is amended as suggested in the outstanding Office Action and the specification is amended to set forth section headings as required under 37 C.F.R. § 1.77(b), and to capitalize the word TEFLON. Accordingly, Applicants respectfully submit that the objections to the Title and specification are overcome.

Regarding the rejection of Claims 14-24 as indefinite, as discussed in the personal interview, Claim 14 is amended to provide antecedent basis for “body” and “the hollow chambers,” clarify “a rise in a path,” and to delete the term “securely;” Claims 18 and 19 no longer recite “Teflon” and “at least” is amended to read “the at least;” Claim 14 provides proper antecedent basis for “the hollow chamber” in Claims 20 and 21; Claim 21 has proper antecedent basis for “the body” from Claim 14 and is amended to clarify “non-magnetic body;” and Claim 24 (referred to in the outstanding office action as Claim 23) is amended to recite “plural coating agents are applied to the hollow profile strand, one after the other.” Thus, it is respectfully requested that the rejection of Claims 14-24 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Regarding the rejection of Claims 14-17, 20, and 22-24 as unpatentable over EP ‘617 in view of U.S. ‘587, that rejection is respectfully traversed by the present response.

As discussed in the personal interview, Claim 14 is amended without prejudice or disclaimer to further enhance the feature of the at least one wiping lip and its relation to the inner walls. Specifically, amended independent Claim 14 recites, in part:

**wiping excess liquid coating agent from one or more
inner walls of the hollow chambers by liquid wipers
mounted inside the hollow chambers, by moving the hollow
profile strand continuously in relation to the liquid wipers,**

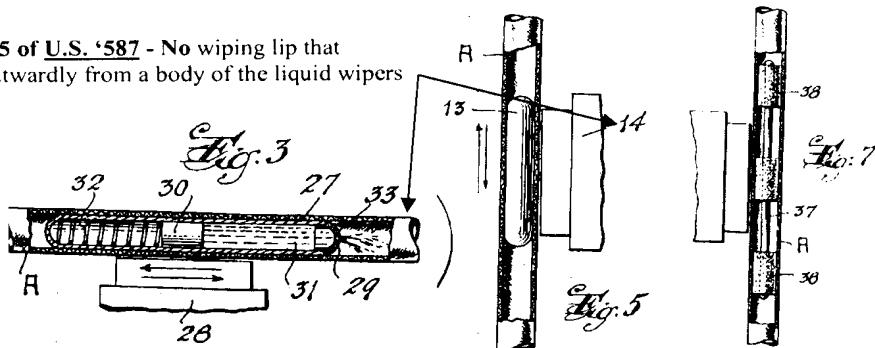
wherein the liquid wipers include at least one magnet or magnetizable material and at least one wiping lip that touches only a portion of a cross-sectional perimeter of the inner walls, the liquid wipers being arranged in a region of the rise in the path of the hollow profile strand downstream of the supply of the liquid coating agent and being held at a constant position within the path of the hollow profile strand by counter magnets or magnetizable materials, which are fixed next to an outer side of the continuous hollow profile strand.

Thus, the liquid wipers include at least one wiping lip that touches only a portion of a cross-sectional perimeter of the inner walls.

As discussed during the personal interview, EP ‘617 and U.S. ‘587 fail to disclose the above-noted feature. The outstanding Office Action acknowledges that EP ‘617 is devoid of liquid wipers recited in Claim 14.¹

Moreover, as further discussed during the interview, U.S. ‘587 fails to remedy the deficiencies EP ‘617. The wiping elements of U.S. ‘587, as depicted in Figs. 3, 5, and 7 (shown below), for example, do not include a “wiping lip,” much less one that “touches only a portion of a cross-sectional perimeter of the inner walls,” as recited in Claim 14. Instead, the surfaces of the wiping elements in Figs. 3, 5, and 7 are depicted as smooth, and include no structures resembling **wiping lips**. Moreover, the rubber wiper sections of Fig. 7 wipe the **entire cross-sectional perimeter** of the inner walls of the tubing.

Figs. 3 and 5 of U.S. ‘587 - No wiping lip that protrudes outwardly from a body of the liquid wipers



¹ Office Action at page 7, lines 15 and 16.

Accordingly, both EP ‘617 and U.S. ‘587 fail to disclose “at least one wiping lip that touches only a portion of a cross-sectional perimeter of the inner walls,” as recited in Claim 14. Thus, Claim 14 patentably defines over the cited references since EP ‘617, taken alone or in combination with U.S. ‘587, fails to disclose all of the features recited in Claim 14, or the claims depending therefrom. Therefore, Applicants respectfully request the rejection of Claims 14-17, 20, and 22-24 under 35 U.S.C. § 103(a) be withdrawn.

Applicants note that new Claims 27-30 recite features which further enhance the at least one wiping lip recited in Claim 14, and respectfully submit that these claims further patentably define over the cited references for the features they recite, in addition to their dependency from underlying base claims.

Regarding Claim 20, as noted by Applicants’ representatives during the personal interview, other than a statement of obviousness, the outstanding Office Action provides no documentary evidence for its assertion that the features of Claim 20 would have been readily apparent to one having ordinary skill in the art at the time the invention was made. MPEP § 2144.03 specifically requires such evidence be provided and states that official notice can only be relied on when being used to insubstantially fill in gaps, and not when being substituted for actual core features.

As discussed in the personal interview, Claim 20 is amended without prejudice or disclaimer to further define the wiping lip. Applicants note that both EP ‘617 and U.S. ‘587 fail to disclose liquid wipers which include “not only the wiping lip including polytetrafluoroethylene or silicone, but also a lip impregnated with coating liquid arranged downstream of the wiping lip,” as recited in Claim 20. Since these features constitute core features, it is improper to use official notice to find these claims obvious. Thus, it is respectfully requested that these features be given patentable weight, and it is respectfully

submitted that Claim 20 patentably distinguishes over the cited references for at least the features recited therein.

Regarding Claim 23, as discussed during the personal interview, this claim is amended without prejudice or disclaimer to recite in part “the first liquid wiper wiping only an upper flange and an upper part of the webs and the second liquid wiper wiping only a lower flange and a lower part of the webs.” As none of the cited references teach the above-noted features, Applicants respectfully submit that Claim 23 patentably distinguishes over the cited references for at least the features it recites, and further by virtue of its dependency from an allowable independent Claim.

Applicants also note that the outstanding Office Action acknowledges that the cited references fail to teach the features of Claim 23 and merely asserts that the cited references could be used to coat a hollow member having any configuration.² Applicants reiterate their position that it is not appropriate to rely solely on common knowledge in the art without evidentiary support in the record, and submit that the assertion that the references may “be used to coat the inner surfaces of hollow members having any configuration, absent evidence to the contrary,” is insufficient evidence to support a finding of obviousness.

Furthermore, as discussed during the personal interview, the arrangement of the hollow strand, as recited in Claim 23, is only one of several features recited in that claim and the cited references fail to disclose these additional features. Specifically, the cited references fail to disclose 1) first and second liquid wipers which are arranged in each of the hollow chambers 2) the first liquid wiper wiping an upper flange and an upper part of the webs and the second liquid wiper wiping a lower flange and a lower part of the webs, and 3) the first liquid wiper located upstream of the second liquid wiper in a direction of the path of the hollow profile strand.

² Office Action at page 9, lines 8-13.

Accordingly, in addition to the above comments, it is respectfully submitted that the outstanding Office Action improperly uses “Official Notice” to reject Claim 23.

Regarding the rejection of Claims 18 and 19 as unpatentable over EP ‘617 in view of U.S. ‘587 and JP ‘504, these claims dependent from an allowable independent base claim and are patentable for at least this reason. Therefore, Applicants respectfully request the rejection of Claims 18 and 19 under 35 U.S.C. § 103(a) be withdrawn.

Further, regarding Claim 19, the outstanding Office Action acknowledges that “none of the references teaches an ePTFE foam of the claimed density.” The outstanding Office Action then concludes “As such, an material capable of applying coating material -- including the claimed ePTFE -- would have been readily apparent to one skilled in the art.”³

Applicants note that it is well established that each word of every claim must be given patentable weight. Specifically, MPEP § 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 19 recites at least one wiping lip which includes expanded polytetrafluoroethylene with a density of from 0.3 to 1.8 g/cm³. The makeup of the at least one wiping lip enhances the method of Claim 19 and must be considered. Accordingly, since no proper combination of the cited references teaches or suggests the above-noted features, this claim patentably defines over the cited references for at least this reason.

As discussed during the personal interview regarding the rejection of Claim 21 as unpatentable over EP ‘617 in view of U.S. ‘587 and U.S. ‘805, Applicants note that EP ‘617, taken alone or in combination with U.S. ‘587 and U.S. ‘805, fails to disclose the “rollers” recited in Claim 21.

³ Office Action at page 10, lines 8-13.

⁸ See MPEP § 2143.03 citing In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

EP ‘617 and U.S. ‘587 are acknowledged in the outstanding Office Action as failing to disclose the “rotatable rollers” recited in Claim 21. U.S. ‘805 discusses a pipeline pig which can be pulled through a pipeline to line it with a plastic composition and suggests in passing that “resiliently arranged rollers” may be used as guide bodies.⁴ No additional description or depiction of these resiliently arranged rollers is provided by U.S. ‘805. Thus, this minimal description of “resiliently arranged rollers” in U.S. ‘805 is insufficient to set forth the “rotatable rollers” of Claim 21. Therefore, U.S. ‘805 fails to disclose the features recited in Claim 21.

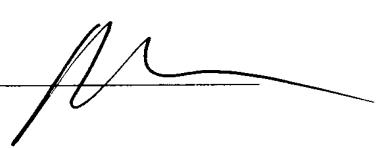
Accordingly, since no proper combination of EP ‘617, U.S. ‘587, and U.S. ‘805 would include all the features of Claim 14, Claim 21, which depends from Claim 14, patentably defines over the cited references for at least this reason. Therefore, Applicants respectfully request the rejection of Claim 21 under 35 U.S.C. § 103(a) be withdrawn.

Consequently, in light of the above discussion and in view of the present Amendment, the present Application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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⁴ U.S. ‘805 at col. 1, lines 55-65.